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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,050	02/26/2004	Yoshihiro Ogawa	02910.000121.	3302
5514	7590	09/07/2006		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER	
			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/786,050	OGAWA ET AL.	
	Examiner	Art Unit	
	Janis L. Dote	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 July 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-6 9, and 10 is/are rejected.
- 7) Claim(s) 8,11 and 12 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on Jul. 31, 2006, has been entered.

2. The examiner acknowledges the amendment to claim 1, the cancellation of claims 3 and 7, and the addition of claims 10-12 set forth in the amendment filed on Jun. 29, 2006, which was entered upon the filing of the RCE. The examiner also acknowledges the amendments to claims 9 and 12 set forth in the amendment filed on Jul. 31, 2006. Claims 1, 4-6, and 8-12 are pending.

3. The rejections under 35 U.S.C. 103(a) of claims 3 and 7 over US 6,677,092 B2 (Arai) combined with WO 03/073171 A1 (Kishiki) and of claims 3 and 7 over US 4,857,432 (Tanikawa'432) combined with Kishiki, set forth in the office action mailed on Mar. 29, 2006, paragraphs 5 and 6, respectively, have been withdrawn in response to the amendment to claim 1 filed on

Jun. 29, 2006. That amendment added the limitation that the Ti chelate compound is represented by any one of the formulae (I) to (IV) and hydrates thereof. None of the cited references teaches or suggests the Ti chelate compound recited in instant claim 1. In particular, as discussed in the rejection in paragraph 5, Kishiki teaches a polyester toner binder resin that is obtained by using a titanium chelate compound as a catalyst, where potassium titanyl oxalate meets the compositional limitation of formula VII recited in now-cancelled claim 3, which is outside scope of formulas (I) to (IV) recited in instant claim 1. Kishiki does not appear to suggest or teach the titanium chelate compound recited in instant claim 1.

The rejections under 35 U.S.C. 103(a) of claims 1, 3, and 5-9 over Arai combined with WO 03/052521 A1 (Kishiki'521) and the other cited prior art, and of claims 1, 3-5, 7, and 8 over Tanikawa'432 combined with Kishiki'521 and the other cited prior art, set forth in the office action mailed on Mar. 29, 2006, paragraphs 7-13, have been withdrawn in response to the amendment to claim 1 filed on Jun. 29, 2006, as described supra. None of the cited prior art teaches or suggests the Ti chelate compound recited in instant claim 1. In particular, as discussed in paragraph 7, Kishiki'521 discloses a particular polyester toner binder resin that is obtained by using a

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potassium titanyl oxalate as a catalyst. Potassium titanyl oxalate meets the compositional limitation of formula VII recited in now-cancelled claim 3, which is outside scope of formulas (I) to (IV) recited in instant claim 1.

4. The examiner notes that the term "average circularity" is defined at page 48, lines 1-13, as the "value determined by dividing the sum of measured circularity values of total particles having equivalent circle diameters of 3 μm to 400 μm , by the number of total particles," where the circularity is defined as L_o/L where "L_o represents a circumferential length of a circle having an area identical to that of a projected particle image, and L represents a circumferential length of the projected particle image processed at an image processing resolution of 512 X 512 (0.3 μm X 0.3 μm pixel)."

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 7,029,813 B2 (Mikuriya) in view of US 6,197,470 B1 (Tamura) and US 4,847,432 (Tanikawa'432), as evidenced by US 6,379,855 B1 (Hayashi).

Reference claim 2, which depends from reference claim 1, recites toner particles comprising a colorant, a release agent, a polar resin, and an inorganic fine powder. The polar resin comprises a polyester unit polymerized in the presence of a titanium chelate catalyst that meets the Ti chelate catalyst limitations recited in instant claims 1 and 10. See formulas (I) to (IV) in reference claim 2. The toner particles are obtained by carrying out granulation in an aqueous medium. Reference claim 9, which depends from reference claim 1, recites that the toner particles are obtained by dispersing in an aqueous medium a polymerizable monomer composition that contains at least a polymerizable monomer, the colorant, the polar resin, the release agent, a charge control agent and a polymerization

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initiator, granulating the polymerizable monomer composition, and polymerizing the polymerizable monomer.

The reference claims of Mikuriya do not recite that the toner can be a magnetic toner as recited in the instant claims. However, it is well known in the toner art that magnetic substances can be used as a toner colorant. See Tamura, col. 18, lines 56-64.

Tanikawa'432 discloses a magnetic toner that comprises toner particles that comprise particular magnetic iron oxide particles, a binder resin, and a particular charge control agent. The magnetic toner also comprises hydrophobic silica particles. Example 1 at col. 14; and Table 2 at col. 17, example 1. The magnetic toner has a saturation magnetization of 30.3 emu/g and a residual (i.e., remanent) magnetization of 5.9 emu/g in a magnetic field of 10 KOe. Table 2, example 1. The saturation magnetization of 30.3 emu/g, i.e., 30.3 Am²/g, together with the residual magnetization of 5.9 emu/g, i.e., 5.9 Am²/g, in a magnetic field of 10 KOe, i.e., 795.8 kA/m, meet the magnetization limitations recited in instant claim 1. See Hayashi, col. 7, lines 30-35, equating 1 emu/g to 1 Am²/g, and a magnetic field of 795.8 kA/m to 10 KOe. According to Tanikawa'432, the magnetic toner particles can be obtained by a polymerization method in which the predetermined toner materials

are "mixed in a monomer which should constitute the binder resin to form a suspension, followed by polymerization, to obtain the toner." Col. 12, lines 9-12. The method disclosed by Tanikawa'432 appears to be similar to the method recited in reference claim 9. Tanikawa'432 further teaches that the magnetic toner provides "stable toner images without the influence from changes in the environment such as temperature change, humidity change." The magnetic toner can also provide stable images even in continuous use for a long period of time. Col. 2, lines 5-12, and Table 1 at col. 15, example 1.

It would have been obvious for a person having ordinary skill in the art, in view of the subject matter recited in the claims of Mikuriya and the teachings of Tanikawa'432, to use the Tanikawa'432 magnetic particles and the Tanikawa'432 charge control agent as the colorant and the charge control agent in the toner recited in the claims of Mikuriya, such that the resultant magnetic toner has the saturation and remanent magnetizations as recited in instant claim 1. That person would have had a reasonable expectation of successfully obtaining a magnetic toner having the advantages taught by Tanikawa'432.

7. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

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claims 1-9 of Mikuriya in view of Tamura and Tanikawa'432, as evidenced by Hayashi, further in view with US 6,218,065 B1 (Tanikawa'065).

The subject matter recited in the claims of Mikuriya in view of the teachings in Tamura and Tanikawa'432, as evidenced by Hayashi, renders obvious a magnetic toner as described in paragraph 6 above, which is incorporated herein by reference.

Tanikawa'432 does not exemplify a magnetic toner comprising magnetic iron oxide particles comprising 0.1 to 2.0% by weight of an "Si element" as recited in instant claim 4.

Tanikawa'065 teaches that it is most preferred that the magnetic iron oxide used in magnetic toners contain a "different element" selected from the group consisting of magnesium, aluminum, silicon, phosphorus, and zirconium. Col. 48, lines 16-19. Tanikawa'065 teaches that the "different element" may be: introduced into the crystal lattice of the iron oxide; incorporated as an oxide thereof in the iron oxide; or present as an oxide or a hydroxide on the surface of the iron oxide particles. Col. 48, lines 20-23. According to Tanikawa'065, such a magnetic iron oxide containing such a different element exhibits a good affinity with and very good dispersibility in the toner binder resin, which can be a polyester binder resin. Col. 46, lines 29-31, and col. 48, lines 32-34. Tanikawa'065

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further teaches that the "different element" is preferably present at 0.2 to 5 wt% based on the iron element. If the amount is below 0.05 wt%, the "addition effect of the different element is scarce, thus failing to achieve good dispersibility and uniformity of chargeability." If the amount is greater than 10 wt%, the "charge liberation is liable to be excessive to cause insufficient chargeability, thus resulting in a lower image density and an increased fog." Col. 49, lines 1-8. Thus, the prior art reference recognizes that the amount of the "different element" in the magnetic iron oxide particles is a result-effective variable. The variation of a result-effective variable is presumably within the skill of the ordinary worker in the art. Tanikawa'065 exemplifies magnetic iron oxide particles comprising Si in an amount of 2 wt% or 0.5 wt% based on the iron element of the particles. See Table 3 at col. 59, magnetic material (i) and (ii). The amounts of 2 wt% and 0.5 wt% are within the range of 0.1 to 2 wt% recited in instant claim 4.

It would have been obvious for a person having ordinary skill in the art, in view of the teachings of Tanikawa'065, to incorporate the element Si in the Tanikawa'432 magnetic iron oxide particles as taught by Tanikawa'065, such that the resultant magnetic iron oxide particles comprise Si in an

amount, such as 0.5 or 2 wt% based on the iron content, that is within the amount recited in instant claim 4, and to use the resultant magnetic iron oxide particles in the magnetic toner rendered obvious over subject matter recited in the claims of Mikuriya combined with the teachings of Tamura and Tanikawa' 432, as evidenced by Hayashi. That person would have had a reasonable expectation of successfully obtaining a magnetic toner having improved dispersibility of the magnetic iron oxide particles in the binder resin, and improved uniformity of chargeability as taught by Tanikawa' 065.

8. Claim 5 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of Mikuriya in view of Tamura and Tanikawa' 432, as evidenced by Hayashi, further in view of additional teachings in Tamura.

The subject matter recited in the claims of Mikuriya in view of the teachings in Tamura and Tanikawa' 432, as evidenced by Hayashi, renders obvious a magnetic toner as described in paragraph 6 above, which is incorporated herein by reference.

The claims in Mikuriya do not recite and Tanikawa' 432 does not disclose a hydrophobic silica as recited in instant claim 5.

Tamura teaches hydrophobic silica particles that are treated with hexamethyldisilazane and a dimethylsilicone oil. Col. 22, lines 35-56, hydrophobic fine silica powder A; and Table 1 at col. 25, treated silica A. The Tamura hydrophobic silica powder A has particular hydrophobic properties. Col. 2, lines 34-49; and Table 2 at col. 25, treated silica A. According to Tamura, when the Tamura hydrophobic silica powder A is externally added to a toner, the toner can keep smeared images from occurring even in an environment of high temperature and high humidity. The toner has good transfer efficiency and does not cause melt abrasion of the photosensitive drum. Col. 2, lines 10-22.

It would have been obvious for a person having ordinary skill in the art to use the Tamura hydrophobic silica powder A as an externally added hydrophobic silica in the magnetic toner rendered obvious over subject matter recited in the claims of Mikuriya combined with the teachings of Tamura and Tanikawa'432, as evidenced by Hayashi. That person would have had a reasonable expectation of successfully obtaining a magnetic toner that has good transfer efficiency, that does not cause melt abrasion of the photosensitive drums, and that provides images without smearing even in an environment of high temperature and high humidity, as taught by Tamura.

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9. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of Mikuriya in view of Tamura and Tanikawa'432, as evidenced by Hayashi, further in view of Tanikawa'065.

The subject matter recited in the claims of Mikuriya in view of the teachings in Tamura and Tanikawa'432, as evidenced by Hayashi, renders obvious a magnetic toner as described in paragraph 6 above, which is incorporated herein by reference.

The claims in Mikuriya do not recite and Tanikawa'432 does not disclose the use of a metal aromatic hydroxycarboxylate as recited in instant claim 9. However, Tanikawa'432 teaches that charge controlling agents known in the art may be also employed in its magnetic toner, "if they do not exert deleterious influences." Tanikawa'432, col. 10, lines 23-26.

Tanikawa'065 teaches organic zirconium complexes of aromatic hydroxycarboxylic acids as toner charge controlling agents. Col. 3, lines 15-25; col. 6, line 60, to col. 7, line 35; and col. 7, line 45, to col. 8, line 27. The Tanikawa'065 zirconium complexes meet the "metal aromatic hydroxycarboxylate" limitation recited in instant claim 9. According to Tanikawa'065, toners comprising said charge controlling compounds have negative triboelectric chargeability, and stably provide high quality images "even when used in a low

humidity environment or in a high humidity environment and not causing image defects with lapse of time." The toner is "less liable to result in deteriorated toner even when used in a cartridge-type developing device of either a replenishment type or a use-up type." The toner also exhibits excellent developing performance and provides "developed images faithful to electrostatic images even in a long term of continuous image formation." Col. 2, lines 1-18. These properties appear to be the same properties sought by Tanikawa'432. As discussed in paragraph 6 above, Tanikawa'432 teaches that its magnetic toner provides "stable toner images without the influence from changes in the environment such as temperature change, humidity change"; and that it provides stable images even in continuous use for a long period of time.

It would have been obvious for a person having ordinary skill in the art to use the Tanikawa'065 charge control agent zirconium complex of an aromatic hydroxycarboxylic acid in the magnetic toner rendered obvious over subject matter recited in the claims of Mikuriya combined with the teachings of Tamura and Tanikawa'432, as evidenced by Hayashi. That person would have had a reasonable expectation of successfully obtaining a negative triboelectric chargeable magnetic toner having the advantages disclosed by Tanikawa'065 and Tanikawa'432.

10. Applicant's arguments filed on Jun. 29, 2006, as applicable to the rejections in paragraphs 6-9 above have been fully considered but they are not persuasive.

Applicants assert that instant claim 1 does not recite the presence of certain elements recited in reference claim 1 of Application 10/717,452 (Application'452), i.e., Mikuriya.

Applicants also assert that reference claim 1 of Application'452 does not recite the presence of magnetic iron oxide or that the toner has the magnetizations recited in instant claim 1.

Applicants assert that claims of Application'452 and the claims in the instant application define distinct inventions and that the PTO could have restricted the present claims from the claims of Application'452 had they been presented in a single application.

Applicants' assertions are not persuasive. The subject matter recited in instant claims 1, 4, 5, 9, and 10 is not rendered obvious merely over the subject matter recited in Mikuriya. Rather, as discussed in the paragraphs 6-9, the subject matter recited in instant claims 1, 4, 5, 9, and 10 is rendered obvious over the subject matter recited in the reference claims in Mikuriya in view of the teachings in Tanikawa'432 and the other cited prior art. For example, as

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discussed in paragraph 6 above, Tamura shows that it is well known in the toner art that magnetic substances can be used as a toner colorant. Tanikawa'432 teaches a magnetic toner comprising hydrophobic silica particles and having a saturation magnetization and a remanent magnetization that meet the magnetization limitations recited in instant claim 1 and that said magnetic toner can be obtained by a method that appears to be similar to the method recited in the reference claims of Mikuriya. Tanikawa'432 further teaches that the magnetic toner can comprise a release agent. See Tanikawa'432, col. 11, lines 8-19 and example 1. Thus, for the reasons discussed in the rejections in paragraphs 6-9 above, the examiner has demonstrated that toner recited in instant claims 1, 4, 5, 9, and 10 is an obvious variation of the toner recited in Mikuriya in view of the disclosure of the cited prior art, and are therefore not patentably distinct. Accordingly, the rejections in paragraphs 6-9 stand.

11. The following rejections are provisional obviousness-type double patenting rejections because the conflicting claims in the cited pending US application have not in fact been patented.

12. Claims 1 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of US Application 10/900,177 (Application'177) in view of Tamura and Tanikawa'432, as evidenced by Hayashi.

Reference claim 1 recites a toner comprising toner particles that comprise a colorant, a binder resin, and inorganic fine particles. The binder resin is a resin having a polyester unit synthesized by using a titanium chelate catalyst that meets the Ti chelate catalyst limitations recited in instant claim 1. See formulas (I) to (III) in reference claim 1.

Reference claim 6, which depends from reference claim 1, requires that the toner particles have an average circularity of from 0.930 to 0.990 as measured by a flow type particle image analyzer. The range of 0.930 to 0.990 overlaps the average circularity range of "0.930 or more and less than 0.970" recited in instant claim 6. According to Application'177, the average circularity is defined by an equation that is identical to the equation used in determining the average circularity recited in instant claim 6. See paragraph 4 supra; and Application'177, page 70, line 5, to page 71, line 15. Application'177 states that average circularity is determined by the flow-type particle

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image analyzer FPIA-2100, which appears to be the same analyzer used in the instant specification to determine the average circularity recited in instant claim 6. Application'177, page 70, lines 10-12; and the instant application, page 48, lines 20-26, and page 49, lines 12-26.

Application'177 does not disclose that the average circularity is for particles having equivalent circle diameters of 3 μm to 400 μm as recited in instant claim 6. However, as discussed supra, Application'177 definition of average circularity is identical to the definition of the average circularity recited in instant claim 6. In addition, the Application'177 average circularity is determined by the flow-type particle image analyzer FPIA-2100, which appears to be the same analyzer used in the instant specification to determine the average circularity recited in instant claim 6. Thus, it is reasonable to conclude that the Application'177 average circularity is determined in the same manner as the average circularity recited in instant claim 6. The burden is on applicants to prove otherwise. In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

The reference claims of Application'177 do not recite that the toner can be a magnetic toner as recited in the instant claims. However, it is well known in the toner art that

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magnetic substances can be used as a toner colorant. See Tamura, col. 18, lines 56-64.

Tanikawa'432 discloses a magnetic toner that comprises toner particles that comprise particular magnetic iron oxide particles, a binder resin, and a particular charge control agent, and hydrophobic silica particles. The magnetic toner has a saturation magnetization and a remanent magnetization that meet the magnetization limitations recited in instant claim 1. The discussions of Tanikawa'432 and Hayashi in paragraph 6 above are incorporated herein by reference.

It would have been obvious for a person having ordinary skill in the art, in view of the subject matter recited in the claims of Application'177 and the teachings of Tanikawa'432, to use the Tanikawa'432 magnetic particles and the Tanikawa'432 charge control agent as the colorant and the charge control agent in the toner recited in the claims of Application'177, such that the resultant magnetic toner has the saturation and remanent magnetizations as recited in instant claim 1. That person would have had a reasonable expectation of successfully obtaining a magnetic toner having the advantages taught by Tanikawa'432.

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13. Claim 4 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of Application'177 in view of Tamura and Tanikawa'432, as evidenced by Hayashi, further in view with Tanikawa'065.

The subject matter recited in the claims of Application'177 in view of the teachings in Tamura and Tanikawa'432, as evidenced by Hayashi, renders obvious a magnetic toner as described in paragraph 12 above, which is incorporated herein by reference.

Tanikawa'432 does not exemplify a magnetic toner comprising magnetic iron oxide particles comprising 0.1 to 2.0% by weight of an "Si element" as recited in instant claim 4.

Tanikawa'065 teaches the use of magnetic iron oxide particles comprising Si in magnetic toners. The discussion of Tanikawa'065 in paragraph 7 above is incorporated herein by reference.

It would have been obvious for a person having ordinary skill in the art, in view of the teachings of Tanikawa'065, to incorporate the element Si in the Tanikawa'432 magnetic iron oxide particles as taught by Tanikawa'065, such that the resultant magnetic iron oxide particles comprise Si in an amount, such as 0.5 or 2 wt% based on the iron content, that is

within the amount recited in instant claim 4, and to use the resultant magnetic iron oxide particles in the magnetic toner rendered obvious over subject matter recited in the claims of Application'177 combined with the teachings of Tamura and Tanikawa'432, as evidenced by Hayashi. That person would have had a reasonable expectation of successfully obtaining a magnetic toner having improved dispersibility of the magnetic iron oxide particles in the binder resin, and improved uniformity of chargeability as taught by Tanikawa'065.

14. Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of Application'177 in view of Tamura and Tanikawa'432, as evidenced by Hayashi, further in view of additional teachings in Tamura.

The subject matter recited in the claims of Application'177 in view of the teachings in Tamura and Tanikawa'432, as evidenced by Hayashi, renders obvious a magnetic toner as described in paragraph 12 above, which is incorporated herein by reference.

The claims in Application'177 do not recite and Tanikawa'432 does not disclose a hydrophobic silica as recited in instant claim 5.

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Tamura teaches hydrophobic silica particles that are treated with hexamethyldisilazane and a dimethylsilicone oil. The discussion of Tamura in paragraph 8 above is incorporated herein by reference.

It would have been obvious for a person having ordinary skill in the art to use the Tamura hydrophobic silica powder A as an externally added hydrophobic silica in the magnetic toner rendered obvious over subject matter recited in the claims of Application'177 combined with the teachings of Tamura and Tanikawa'432, as evidenced by Hayashi. That person would have had a reasonable expectation of successfully obtaining a magnetic toner that has good transfer efficiency, that does not cause melt abrasion of the photosensitive drums, and that provides images without smearing even in an environment of high temperature and high humidity, as taught by Tamura.

15. Claim 9 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of Application'177 in view of Tamura and Tanikawa'432, as evidenced by Hayashi, further in view of Tanikawa'065.

The subject matter recited in the claims of Application'177 in view of the teachings in Tamura and Tanikawa'432, as

evidenced by Hayashi, renders obvious a magnetic toner as described in paragraph 12 above, which is incorporated herein by reference.

The claims in Application'177 do not recite and Tanikawa'432 does not disclose the use of a metal aromatic hydroxycarboxylate as recited in instant claim 9. However, Tanikawa'432 teaches that charge controlling agents known in the art may be also employed in its magnetic toner, "if they do not exert deleterious influences." Tanikawa'432, col. 10, lines 23-26.

Tanikawa'065 teaches organic zirconium complexes of aromatic hydroxycarboxylic acids as toner charge controlling agents. The discussions of Tanikawa'065 and Tanikawa'432 in paragraph 9 above are incorporated herein by reference.

It would have been obvious for a person having ordinary skill in the art to use the Tanikawa'065 charge control agent zirconium complex of an aromatic hydroxycarboxylic acid in the magnetic toner rendered obvious over subject matter recited in the claims of Application'177 combined with the teachings of Tamura and Tanikawa'432, as evidenced by Hayashi. That person would have had a reasonable expectation of successfully obtaining a negative triboelectric chargeable magnetic toner

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having the advantages disclosed by Tanikawa'065 and Tanikawa'432.

16. Claims 8, 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Neither the claims in Mikuriya nor the claims in Application'177 recite that the polyester components recited in those claims comprise the compound recited in instant claim 8. Nor do the claims in Mikuriya or the claims in Application'177 recite that the Ti chelate compound comprises Ti chelate compounds (1) and (2), as recited in instant claim 11. Nor do the claims in Mikuriya or the claims in Application'177, alone or combined with the other cited prior art, render obvious a magnetic toner comprising a binder resin comprising a polyester component polymerized by using a Ti chelate compound and the combination of the aluminum compound of formula (13) and a monoazo iron compound, as recited in instant claim 12.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLD
Aug. 31, 2006

Janis L. Dote
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GROUP 1500
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